

REMARKS

Claims 1-49 are pending, with claims 1, 23, and 45 being independent

Claims 1-49 are rejected as obvious over U.S. Patent No. 6,393,464 (Dieterman) in view of U.S. Patent No. 6,920,478 (Mendiola). Applicant requests withdrawal of these rejections for at least two reasons. First, the rejections fail to provide any reasoning supporting obviousness, which is required by the U.S. Supreme Court and the USPTO's Guidelines for Determining Obviousness. Second, these references in fact do not render claims 1-49 obvious because neither reference, either separately or in combination, describes or suggests all of the features of independent claims 1, 23, and 45.

With respect to the first point, the Supreme Court in *KSR International vs. Teleflex Inc.* stated that "rejections on obviousness **cannot** be sustained by mere conclusory statements; instead, there must be **some articulated reasoning** with some rationale underpinning to support the legal conclusion of obviousness." *KSR International vs. Teleflex Inc.*, 550 U.S. at ____ (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)) (emphasis added). The USPTO's recent Guidelines for Determining Obviousness reiterate this requirement for some articulated reasoning to support a rejection of obviousness. Federal Register, Vol. 72, No. 195, page 57528.

In this case, there is zero rationale to support the assertion of obviousness. Instead, the office action merely lists what each reference is purported to disclose, and provides no reasoning as to why these disclosures render the subject matter of claims 1, 23, and 49 obvious. Specifically, the rejection states the following:

Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman et al. (US 6,393,464) as applied to claim 1, and further in view of Mendiola et al. (US 6,920,478).

- Regarding claim 1 & 23 & 45, Dieterman teaches a method for controlling the delivery of electronic mail, (**See Abstract**).

Dieterman et al. differs from the claimed invention is that a method of providing online presence is not taught in Dieterman et al.

Mendiola teaches a method of providing online presence, **[a method and system for tracking and specifying the online status of users of the system, (Column 1, lines 10 - 13)];**

information: accessing a list of people inferred as known to a user, **[a target user can be added to a particular buddy list of a user, (Column 2, lines 17 - 19)];**

accessing online presence information for the user, **[specifying the online status of a user forming part of an instant messaging system, (Column 3, lines 17 - 19) & (Fig. 7, Ref # 709)];**

determining a potential receiver of the online presence information, **[checking means to check the activity status of each user stored on said database, (Column 3, lines 34 - 36) & (Fig. 7, Ref # 701, 705)];**

Dieterman further teaches comparing the potential receiver to the accessed list to determine if the potential receiver is included on the list, **[Fig. 4, the recipients of the outgoing message are compared to the identities appearing on the allowed list, step 72];** and determining whether to communicate the online presence information to the potential receiver based on whether the potential receiver is included in the list, **[Fig. 4, a determination is made whether each designated recipient is on the list, step 73].**

As can be seen, the rejection starts by stating that claims 1-49 are rejected as obvious over Dieterman in view of Mendiola. The rejection then proceeds to state what each of Dieterman and Mendiola are purported to disclose. Then the rejection ends. There is no articulated reasoning as to why the claimed subject matter is obvious in view of these purported disclosures. As such, the rejection amounts to no more than a mere conclusory statement and therefore the rejection does not present a *prima facie* case of obviousness.

Moreover, with respect to the second point, these references in fact do not render the subject matter of claims 1, 23, and 49 obvious because these references do not describe or suggest all of the features of these claims. In particular, these references fail to describe or suggest at least "determining whether to communicate [online presence information for a user] to [a] potential receiver based on whether the potential receiver is included in [a list of people inferred as known to the user]," as recited in independent claim 1, and similarly in independent claims 23 and 49

As noted in the office action, Dieterman describes controlling the delivery of electronic mail, but does not describe controlling or even providing online presence information.

Therefore, Dieterman does not describe "determining whether to communicate [online presence information for a user] to [a] potential receiver based on whether the potential receiver is included in [a list of people inferred as known to the user]."

The Office Action seems to rely on Mendiola for a description of online presence information. However, Mendiola, at most, simply describes providing online presence information to receivers who put the user in the *receiver's* buddy list. Mendiola, col. 2, lines 26-28. Thus, at most, Mendiola describes determining whether to communicate online presence information for a user to a potential receiver based on whether the *user* is included in a list of the *receiver*, not based on whether the potential *receiver* is on a list of people inferred to be known to the *user*. Consequently, Mendiola also fails to describe "determining whether to communicate [online presence information for a user] to [a] potential receiver based on whether the potential receiver is included in [a list of people inferred as known to the user]."

Furthermore, neither of these references suggests "determining whether to communicate [online presence information for a user] to [a] potential receiver based on whether the potential receiver is included in [a list of people inferred as known to the user]." Dieterman describes sending or holding messages sent by a user based on an approved recipient list for the user. Dieterman, Fig. 3 and col. 4, lines 13-51. However, this does not suggest determining whether to communicate Mendiola's online presence information for a user to a potential receiver based on whether the potential receiver is included in a list of people inferred as known to the user. Online presence information and e-mail are generally not considered equivalent (and indeed there is no evidence demonstrating such). Consequently, Dieterman's description of filtering messages sent by a user based on an approved recipient list for the user does not suggest doing the same thing for Mendiola's online presence information.

Accordingly, for the foregoing reasons, the Applicant requests that the rejections of independent claims 1, 23, and 49, and the claims that depend from them, be withdrawn.


It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Examiner's characterizations of the art, does not signify agreement with or concession of that rejection,

issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 1/11/08



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